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EXAMINER				
ZURITA, JAMES II				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/624,170

**Applicant(s)**

BRIDGELALL, RAJ

**Examiner**

JAMES ZURITA

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 09/04/2008 has been entered.

### ***Response to Amendment***

On 4 September 2008, applicant amended claims 1, 3, 4, 9-10, 12-13, 15-17, 20-22, 26 and 38. Claims 1-40 are pending and will be examined.

### ***Claim Objections***

Claims 2-40 refer to "...the system of claim 1, the .... component ..." and should be amended to read "...the system of claim 1, wherein the .... component ..." See MPEP 608.01(m).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 refers to "...An m-commerce **system**, the system is recorded on a computer-readable media and capable of execution by a computer, comprising ...component [various]..." A system is an apparatus. A component, according to applicant may be software, hardware and combinations of hardware and software:

As used in this application, the terms "component" and "system" are intended to refer to a computer-related entity, either hardware, a combination of hardware and software, software, or software in execution. For example, a component may be, but is not limited to being, a process running on a processor, a processor, an object, an executable, a thread of execution, a program, and/or a computer. By way of illustration, both an application running on a server and the server can be a component. Page 4, line 29- page 5, line 5.

Thus, claims 1-40 appear to be directed to software per se, since the components would otherwise not be able to be recorded on a computer-readable media.

For purposes of examination, the claims are interpreted as being directed to an apparatus. Prior art will be interpreted to meet the limitations where prior art discloses apparatus that is reasonably capable of performing the intended functions.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As used in this application, the terms "component" and "system" are intended to refer to a computer-related entity, either hardware, a combination of hardware and software, software, or software in execution. For example, a component may be, but is not limited to being, a process running on a processor, a processor, an object, an executable, a thread of execution, a program, and/or a computer. By way of illustration, both an application running on a server and the server can be a component. Page 4, line 29-page 5, line 5.

Applicant does not explain how hardware such as a system, a processor and a computer is capable of being recorded on a computer-readable media.

For purposes of examination, the claims are interpreted as being directed to an apparatus. Prior art will be interpreted to meet the limitations where prior art discloses apparatus that is reasonably capable of performing the intended functions.

### ***Claim Rejections - 35 USC § 112***

Claims 4, 9, 10, 12, 13, 15-17, 20-22, 26 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 9, 10, 12, 13, 15-17, 20-22, 26 and 38 contain the conditional OR. Claim 12 also contains the term and/or. The term renders the claims indefinite, since it is not possible to determine the scope of the claim as requiring both items or only one of the items separated by the or. For purposes of this examination, examiner will give the term its broadest reasonable interpretation and consider that the particular condition is

satisfied if one of the limitations is met. The Examiner suggests changing the limitation back to ...and...

For purposes of examination, the claims are interpreted as being directed to an apparatus. Prior art will be interpreted to meet the limitations where prior art discloses apparatus that is reasonably capable of performing the intended functions.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Prior art is interpreted to read on applicant's claims where prior art discloses structure and product reasonably capable of performing applicant's claimed functions.

Claims 1-18, 22-35 and 40, as interpreted, are rejected under 35 U.S.C. 103(a) as being unpatentable over VanErlach (US PG-PUB 20040204063) in view of Gellman (US PG-PUB 2002/0035536).

As per claim 1, VanErlach discloses m-commerce system, the system is recorded on a computer-readable media and capable of execution by a computer, comprising:

a data input component that receives item data representative of an article of commerce; (see, for example, at least paragraph 0007, Fig. 3, wireless device 1);

a coordination component that presents the article of commerce from a shopping list to a vendor for bid, (see, for example, at least paragraph 0032), the coordination

component receives the bid for transacting the article of commerce in real-time;  
(VanErlach, paragraph 0017)

a location awareness component that tracks the location of the data input component (see, for example, at least paragraph 0016); and

a payment component that facilitates payment of the article of commerce (see, for example, at least paragraph 0017) provides secure communication.

As per claim 1 VanErlach **does not** use the term shopping list. This feature is disclosed by Gellman. See, for example, at least paragraph 0008. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine VanErlach and Gellman to disclose, presenting the article of commerce from a shopping list to a vendor for bid because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

VanErlach **does not** specifically disclose that the input component provides an alert when it is within physical proximity of the vendor that is presented the bid. It would have been obvious to one of ordinary skill at the time the invention was made to include that the input component provides an alert when it is within physical proximity of the vendor that is presented the bid, because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

As per claim 2, VanErlach discloses that the data input component is a wireless portable terminal (see, for example, at least paragraph 0002).

As per claim 3, VanErlach and Gellman disclose that the data input component uploads a shopping list (Gellman, paragraph 0008) to the coordination component.

As per claim 4, VanErlach discloses that the data input component downloads item information from at least one of an appliance or a computer (see, for example, at least paragraph 0028).

As per claim 5, VanErlach discloses that the data input component is in continuous communication with the coordination component (see, for example, at least paragraph 0016).

As per claim 6, VanErlach discloses that the data input component communicates information using a virtual private network (see paragraph 0012; see also Fig. 4, for connection to telcomm service provider).

As per claim 7, VanErlach does not specifically disclose that a user of the data input component specifies a price range for a list of the articles of commerce, in response to which the coordination component receives] one or more of the bids to transact the list. This feature is disclosed by Gellman. See, for example, at least paragraph 0036. For lists, see Gellman, paragraph 0008. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine VanErlach and Gellman to disclose shopping lists and to specify a price range for a list of the articles of commerce, in response to which the coordination component receives] one or more of the bids to transact the list because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

As per claim 8, VanErlach discloses that the data input component locates the article of commerce via RF backscattering (see, for example, at least paragraph 0012).



As per claim 9, VanErlach discloses that the data input component facilitates receiving the item data by at least one of manual input, a dataform scanning system, an image capture system, an audio input system, a magnetic reading assembly, or an RF transponder reading assembly see, for example, at least paragraph 0007, Fig. 3, wireless device 1).

As per claim 10, VanErlach discloses that the location awareness component includes at least one of a GPS system, a general packet radio services network, and a RTLS architecture (see, for example, at least paragraph 0016)

As per claim 11, VanErlach discloses the coordination component facilitates communication of awareness data to both the data input component or a vendor (see, for example, at least paragraph 0012 and references to retail stores).

As per claim 12, VanErlach discloses that the awareness data communicated to the data input component provides at least one of notification that the vendor is located nearby, and a name and/or an address of the vendor (see, for example, at least paragraph 0030).

As per claim 13, VanErlach discloses that the awareness data communicated to the vendor provides at least one of identification of the user of the data input component or notification that the data input component is located nearby (see, for example, at least paragraph 0015, concerning identifying information about the device or shopper).

As per claim 14, VanErlach discloses that the awareness data facilitates pushing marketing information to the user of the data input component, which marketing information is targeted to the user (see, for example, at least paragraph 0032).

As per claim 15, VanErlach discloses that the coordination component is disposed at least one of remotely on a global communication network or a local backoffice network (see, for example, at least paragraph 0012 and references to the Internet, a global communication network).

As per claim 16, VanErlach discloses that the coordination component coordinates inter-component functions between the data input component (wireless device), the location awareness component (GPS system, for example), or the payment component (see, for example, at least paragraph 0017).

As per claim 17, VanErlach discloses that the secure payment component provides secure communication using at least one of a biometric, radio frequency identification (RFID) data, or an article-of-commerce dataform (see, for example, at least paragraph 0029).

As per claim 18, VanErlach discloses that the secure payment system distinguishes selection of a first article of Commerce from a second article of commerce by processing both RFID data and dataform data of the first article of commerce (see, for example, at least paragraph 0012, since each article of commerce has a RFID or barcode).

As per claim 22, VanErlach discloses that the data input component outputs at least one of a map or location information that indicates the location of the article of commerce in a store (see, for example, at least paragraph 0013).

As per claim 23, VanErlach discloses that the data input component receives via the coordination component, item information associated with the article of commerce (see, for example, at least paragraph 0013).

As per claim 24, VanErlach discloses that the coordination component retrieves item information associated with the article of commerce from a vendor data resource, and downloads the information to the data input component for presentation to the user (see, for example, at least paragraph 10015).

As per claim 25, VanErlach discloses that the coordinating component manages a transaction between a user of the data input component and a vendor selected to provide the article of commerce (see, for example, at least paragraph 0012, see also references to purchasing via download or physical shipment, as in paragraph 0028).

As per claim 26, VanErlach discloses that the security component facilitates at least one of deactivation or activation of an RFID tag associated with the article of commerce when the data input component reads RFID tag data (see, for example, at least paragraph 0012).

As per claim 27, VanErlach discloses that the secure payment component authenticates the data input component to a store network (see, for example, at least paragraph 0017).

As per claim 28, VanErlach discloses that the location awareness component tracks the data input component in a wide area network and a local area network (see, for example, at least paragraph 0012, for internet, a wide area network; see also at least paragraph 0016 for local wireless network).

As per claim 29, VanErlach discloses that the secure payment component utilizes electronic article surveillance (EAS) technology with bi-stable and resettable EAS data in an RFID tag (paragraph 0012).

As per claim 30, VanErlach discloses that the location awareness component automatically updates a vehicle location tracking system to present a location of the vendor offering the bid (see, for example, at least paragraph 0029). See also applicant admissions, page 4 of the Appeal Brief, "...a user can be notified when other ... users are within a given location.

As per claim 31, VanErlach discloses that the location awareness component automatically updates the data input component with store information of a store as the data input component passes within range of a compatible store communication system (see, for example, at least paragraph 0029).

As per claim 32, VanErlach discloses that the data input component automatically notifies a user that the article of commerce is present in the store (see, for example, at least paragraph 0012).

As per claim 33, VanErlach discloses that the data input component automatically notifies a user of a location of the article of commerce in the store (see, for example, at least paragraph 0013).

As per claim 34, VanErlach discloses that the location awareness component facilitating synchronization of data of the data input component with a second data input component over a wireless personal data network (see references to communications methods with other wireless devices, as in the abstract, for example).

As per claim 35, VanErlach discloses that the coordination component downloads multimedia content related to the article of commerce to the data input component in response to the item data being received (see, for example, at least paragraph 0012).

As per claim 40, VanErlach discloses that the data input component is one of a cellular telephone or a connected person data assistant (see, for example, references to cell phone, as in the abstract).

**Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanErlach in view of Gellman and further in view of Freund (US PG-PUB 20030187787).**

As per claims 19-21, VanErlach does not specifically disclose that the payment component facilitates secure communication of item data via a secure key cryptographic engine (claim 19). VanErlach does not specifically disclose that the engine receives as an input at least one of a manufacturer's key, a retailer's key, a unique item ID, and a locate command (claim 20). VanErlach does not specifically disclose that the engine outputs at least one of a product lookup code and a set/reset password (claim 21).

As per claim 19, Freund discloses that the payment component facilitates secure communication of item data via a secure key cryptographic engine. See, for example, at least paragraph 0012.

As per claim 20, Freund discloses that the engine receives as an input at least one of a manufacturer's key, a retailer's key, a unique item ID, and a locate command. See, for example, at least paragraph 0014.

As per claim 21, Freund discloses that the engine outputs at least one of a product lookup code and a set/reset password. See, for example, paragraph 0051.

It would have been obvious for one of ordinary skill at the time the invention was made to combine VanErlach with Freund to disclose that the payment component facilitates secure communication of item data via a secure key cryptographic engine (claim 19), that the engine receives as an input at least one of a manufacturer's key, a retailer's key, a unique item ID, and a locate command (claim 20) and that the engine outputs at least one of a product lookup code and a set/reset password (claim 21) because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

**Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanErlach in view of Gellman and further in view of Edgett et al. (US PG-PUB 20040034771).**

VanErlach does not specifically disclose that the data input component transmits a unique password to a tag of the article of commerce to facilitate payment for that article of commerce (claim 36). VanErlach does not specifically disclose that the tag is an RFID tag that compares the unique password with a password of the RFID tag (claim 37). These features are disclosed by Edgett, as in paragraph 0049, for example.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine VanErlach and Edgett to disclose that the data input component transmits a unique password to a tag of the article of commerce to facilitate payment for that article of commerce (claim 36), and to disclose that the tag is an RFID tag that compares the unique password with a password of the RFID tag (claim 37) because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

**Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over VanErlach in view of Gellman and further in view of Grunes et al., US PG-PUB 2002/0113707.**

As per claim 38, VanErlach does not specifically disclose that the tag is at least one of received programmed with the password and programmed with the password at a time of source marking. This is disclosed by Grunes, paragraph 0016. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine VanErlach and Grunes to disclose that the tag is at least one of received programmed with the password and programmed with the password at a time of source marking because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

**Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over VanErlach in view of Gellman and further in view of Hoffberg (US 6791472).**

As per claim 39, VanErlach does not specifically disclose that the secure payment system includes a tag communication process that is prioritized according to a bandwidth provisioning architecture. This is disclosed by Hoffberg, as in Col. 25, line 60-col 27, line 35.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine VanErlach and Hoffberg to disclose that the secure payment system includes a tag communication process that is prioritized according to a bandwidth provisioning architecture because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

### ***Response to Arguments***

Applicant's arguments filed 09/04/2008 have been fully considered but they are not persuasive.

In response to applicant's numerous assertions concerning what is taught by VanErlach, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant argues,

Moreover, nowhere do VanErlach or Gellman disclose that the data input component provides an alert when it is within physical proximity of the vendor that is presented the bid. VanErlach discloses "a user reads or enters a product code with or into a wireless device and selects a user interface option that allows a price and inventory lookup within a user-defined distance from the geographic position of the device as



determined by global positioning systems." VanErlach, paragraph 0013. However, nowhere does VanErlach provide an alert when the data input component itself is within physical proximity, let alone when the data component is within physical proximity of the vendor that is presented a bid. Gellman fails to cure these deficiencies.

In response, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James ZUrita/  
Primary Examiner  
Art Unit 3625  
232 November 2008